REMARKS

In the above Office Action there were no rejections under 35 U.S.C. §112 or objections to the specification.

Claim Rejections - 35 U.S.C. § 102(e)

In the above Office Action Claims 1-64 were rejected under the provisions of 35 U.S.C § 102(e) as anticipated by U.S. Patent No. 6,006,264 to Colby et al. (Colby). Applicants respectfully traverse this rejection on the basis that Colby selects servers based upon content while the claimed invention selects upon network characteristics. The claimed invention monitors the entire network to determine the best path, while Colby only receives network information from the selected server. The rejections will be treated on a claim by claim basis.

As to Claim 1, the Office Action states that Colby at column 2, lines 47-59 teaches "directing a network client to a said one of said content servers based on one or more cost measurements indicative of operational characteristics of the network." A check of the citation shows that this language is not present. The sections referred to in Colby do not in any way relate to obtaining a new cost measurement when said network client accesses said content server. Colby does refer to the selection of a server to deliver the content to a client, directing the client to the server is based on a much broader set of criteria than what is in the claimed invention. The claimed invention in Claim 1 is limited to methods where the client direction is based on one or more cost measurements indicative of the operational characteristics of the **network**. This is not related to any of the attributes listed by Colby in the cited section. Colby refers to attributes such as the **type of content**, the **QoS requirements** implied by the request, or **server load**; all of which are reported or interpreted as opposed to actual measurements. For this reason Colby does not teach one of the elements of Claim 1 and cannot therefor anticipate Claim 1. Applicants respectfully request reconsideration and passage to allowance of Claim 1.

As to Claim 2, it is respectfully urged that Claim 2 is dependent upon Claim 1 and inherits the limitations thereof and since Claim 1 is allowable for the reasons stated above Claim 2 is also allowable. In addition, while the Office Action states that Colby at column 3, lines 10-27 and column 2, lines 47-59 teaches "obtaining a new cost measurement when said network client accesses said content server"and at column 14, lines 53-67 teaches "using said new cost measurement as an indicator of operational characteristics of the network in connection with

subsequent requests for access to said content that can be provided by said content server." A check of the citations shows that this language is not present. The claimed invention of claim 2 requires acquisition of new data at the time of the client request. Colby refers to making a server choice based on indexing into a collection of existing profiles or attributes. Furthermore, Colby indicates once the QoS requirements of a flow have been calculated, they are stored in a QoS tag, so that they may be subsequently accessed without needing to be recalculated. Colby refers to QoS as it relates to a flow, which is defined to be a series of frames exchanged between two connection endpoints. The claimed invention of Claim 2 refers to a cost measurement as an indicator of operational characteristics of the network. This is clearly not the same as taught in Colby. For each of these reasons Colby does not teach the elements of Claim 2 and cannot therefor anticipate Claim 2. Applicants respectfully request reconsideration and passage to allowance of Claim 2.

As to Claim 3, it is respectfully urged that Claim 3 is dependent upon Claim 1 and inherits the limitations thereof and since Claim 1 is allowable for the reasons stated above Claim 3 is also allowable.

As to Claim 4, it is respectfully urged that Claim 4 is dependent upon Claim 1 and inherits the limitations thereof and since Claim 1 is allowable for the reasons stated above Claim 4 is also allowable. In addition, while the Office Action states that Colby at column 3, lines 10-27 and column 2, lines 47-59 teaches "measuring network performance between said network client and a said one of said content servers" and at column 14, lines 53-67 teaches "using said new cost measurement as an indicator of operational characteristics of the network in connection with subsequent requests for access to said content that can be provided by said content server." A check of the citations shows that this language is not present. Further, Colby does not refer to measuring network performance in any of the cited sections. The invention claimed in Claim 4 contains the specific limitation of measuring network performance between said network client and a said one of said content servers. In contrast, Colby makes reference to selecting a best-fit server using a method which assigns a proximity preference to the identified servers. As later described in Colby, that proximity is not based on network performance but on association of IP addresses to Autonomous Systems. For each of these reasons Colby does not teach the elements of Claim 4 and cannot therefor anticipate Claim 4. Applicants respectfully request reconsideration and passage to allowance of Claim 4.

As to Claim 5, it is respectfully urged that Claim 5 is dependent upon Claim 1 and inherits the limitations thereof and since Claim 1 is allowable for the reasons stated above Claim 5 is also allowable. In addition, while the Office Action states that Colby at column 15, lines 1-48 teaches "where an attribute of network performance comprises network latency." A check of the citations shows that the term "network latency" is not present, only the word latency is found referring to "hop latency" and "flow switch latency (a constant)." These are very different terms, network latency is a dynamic parameter which changes constantly and is path dependent as stated in the specification, while the terms mentioned in Colby are dependent upon the individual server. For each of these reasons Colby does not teach the elements of Claim 5 and cannot therefor anticipate Claim 5. Applicants respectfully request reconsideration and passage to allowance of Claim 5.

As to Claim 6, it is respectfully urged that Claim 6 is dependent upon Claim 5 and inherits the limitations thereof and since Claim 5 is allowable for the reasons stated above Claim 6 is also allowable. In addition, while the Office Action states that Colby at column 8, lines 34-55 and column 3, lines 10-27 teaches "wherein network latency is measured passively by determining the time between a syn ack message sent by said network client and an ack message sent by one of said content servers." Colby makes no reference in any of the cited sections to passively measure network latency. Reference to TCP SYN in column 8, line 36 is for the express purpose of interpreting the request as a request to initiate a flow between the client and server. There is no mention or teaching of the invention by Colby. For each of these reasons Colby does not teach the elements of Claim 6 and cannot therefor anticipate Claim 6. Applicants respectfully request reconsideration and passage to allowance of Claim 6.

As to Claim 7, it is respectfully urged that Claim 7 is dependent upon Claim 4 and inherits the limitations thereof and since Claim 4 is allowable for the reasons stated above Claim 7 is also allowable. In addition, while the Office Action states that Colby at column 11, line 60 to column 12, line 5 teaches "further comprising measuring network performance between said network client and another of said content servers." In fact, there is no discussion by Colby regarding **measuring network performance between said network client and another of said content servers** as the invention claims. Colby teaches the selection and filtering process of a candidate server list. These are not the same thing. There is no mention or teaching of the invention by Colby. Colby makes no reference in any of the cited sections to passively measure

network latency. For each of these reasons Colby does not teach the elements of Claim 7 and cannot therefor anticipate Claim 7. Applicants respectfully request reconsideration and passage to allowance of Claim 7.

As to Claim 8, it is respectfully urged that Claim 8 is dependent upon Claim 1 and inherits the limitations thereof and since Claim 1 is allowable for the reasons stated above Claim 8 is also allowable. The invention claimed in Claim 8 determines the location of said network client by circular intersection and inferring network performances. Colby teaches location using a method which assigns a proximity preference. As later described by Colby, that proximity is not based on network performance but on association of IP addresses to Autonomous Systems. For each of these reasons Colby does not teach the elements of Claim 8 and cannot therefor anticipate Claim 8. Applicants respectfully request reconsideration and passage to allowance of Claim 8.

As to Claim 10, it is respectfully urged that Claim 10 is dependent upon Claim 1 and inherits the limitations thereof and since Claim 1 is allowable for the reasons stated above Claim 10 is also allowable. The invention claimed in Claim 10 further infers network performance of serving said network client from said content server by determining a weighted average of network performance. Colby on the other hand teaches weighting flows in order to reserve and maintain flow pipe bandwidth. These are not the same thing. For each of these reasons Colby does not teach the elements of Claim 10 and cannot therefor anticipate Claim 10. Applicants respectfully request reconsideration and passage to allowance of Claim 10.

As to Claim 11, it is respectfully urged that Claim 11 is dependent upon Claim 1 and inherits the limitations thereof and since Claim 1 is allowable for the reasons stated above Claim 11 is also allowable. Colby fails to teach the invention under the same rationale as outlined for claims 8 and 10. Furthermore, Colby teaches a method for determining which servers are closest to the client. The invention on the other hand teaches measuring network latency (not proximity as defined by Colby) between a content server and a plurality of other network clients. The one-to-many relationship is reversed. For each of these reasons Colby does not teach the elements of Claim 11 and cannot therefor anticipate Claim 11. Applicants respectfully request reconsideration and passage to allowance of Claim 11.

As to Claim 12, the Office Action states that Colby at column 2, lines 47-59; column 10, lines 1-39; and column 6, lines 42-63 teaches "identifying a said one of said content servers

based on said identity of said network server and one or more cost measurements indicative of operational characteristics of the network." A check of the citation shows that this language is not present. The sections referred to in Colby do not in any way relate to obtaining a new cost measurement when said network client accesses said content server. Colby does refer to the selection of a server to deliver the content to a client, directing the client to the server is based on a much broader set of criteria than what is in the claimed invention. The claimed invention in Claim 12 is limited to methods where the client direction is based on one or more cost measurements indicative of the operational characteristics of the **network**. This is not related to any of the attributes listed by Colby in the cited section. Colby refers to attributes such as the **type of content**, the **QoS requirements** implied by the request, or **server load**; all of which are reported or interpreted as opposed to actual measurements. For this reason Colby does not teach one of the elements of Claim 12 and cannot therefor anticipate Claim 12. Applicants respectfully request reconsideration and passage to allowance of Claim 12.

As to Claim 22, the Office Action states that Colby at column 2, lines 47-67; column 5, lines 62-67; column 10, lines 1-37; column 6, lines 42-64; column 3, lines 1-28; column 19, lines 8-19; and column 15, lines 10-47 teaches "method for directing a network client requesting access to content from a network server to one of a plurality of content servers providing said content for said network server, each said content server having an address, said network server having an identity, said method comprising returning the address of a content server that may provide said content the identity of the network server based on one or more cost measurements indicative of operational characteristics of the network, obtaining a new cost measurement when said network client accesses said content server, and using said new cost measurement as an indicator of operational characteristics of the network in connection with subsequent requests for access to said content that can be provided by said content server." A check of the citation shows that this language is not present. The sections referred to in Colby do not in any way relate to obtaining a new cost measurement when said network client accesses said content server. Colby does refer to the selection of a server to deliver the content to a client, directing the client to the server is based on a much broader set of criteria than what is in the claimed invention. The claimed invention in Claim 22 is limited to methods where the client direction is based on one or more cost measurements indicative of the operational characteristics of the **network**. This is not related to any of the attributes listed by Colby in the cited section. Colby refers to attributes

such as the **type of content**, the **QoS requirements** implied by the request, or **server load**; all of which are reported or interpreted as opposed to actual measurements. For this reason Colby does not teach one of the elements of Claim 22 and cannot therefor anticipate Claim 22. Applicants respectfully request reconsideration and passage to allowance of Claim 22.

As to Claim 32, the Office Action states that Colby at column 3, lines 10-27; column 7, lines 58 to column 8, line 15; column 15, lines 1-49; column 16, lines 40-65; column 17, lines 38-58; column 18, line 63 to column 19, line 7; and Fig. 19 teaches "A method for inferring operational characteristics associated with a plurality of network clients to an inferable network client, comprising:

> (a) measuring network latency between a network server and a plurality of network clients;
> (b) determining physical distances between said network clients and an inferable network client; and
> (c) computing a weighted average of said latency measurements as a function of said distances, wherein said weighed average comprises an estimate of the latency between said network server and said inferable network client."

Once again, the cited language is not found in the reference at the points indicated. Note that the one-to-many relationship is reversed between Colby and the invention as described in the rationale for Claim 11. Colby makes no reference to inferring operational characteristics associated with a plurality of network clients to an inferable network client in any of the cited sections. Furthermore, for the same rationale as described for Claim 10, the weighting concept is applied for completely different purposes. The invention uses the technique in order to estimate latency while Colby on the other hand uses a method of weighting for bandwidth allocation of flows. For this reason Colby does not teach one of the elements of Claim 32 and cannot therefor anticipate Claim 32. Applicants respectfully request reconsideration and passage to allowance of Claim 32.

Claim 33 was rejected on ground that "it had similar limitations to Claim 1; therefore it is rejected under the same rationale." Applicants respectfully object to the form of this rejection. It is not sufficient that a claim element be "similar" to an element in another rejected claim under 35 U.S.C. § 102 in order for the rejection to be proper. Anticipation requires identity, *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 613, 225 USPQ 64 (CAFC 1985) the identical invention must be shown in as complete detail as is contained in the patent claim, *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989). The difference is that Claim

1 is a method claim and Claim 33 is directed toward a system that accomplishes the method. The only elements that Claims 1 and 33 have in common is element of "directing a network client to a said one of said content servers based on one or more cost measurements indicative of operational characteristics of the network." In the Office Action rejecting Claim 1, it is stated that limitation is found in Colby at column 2, lines 47-59. A check of the citation shows that this language is not present. The sections referred to in Colby do not in any way relate to obtaining a new cost measurement when said network client accesses said content server. Colby does refer to the selection of a server to deliver the content to a client, directing the client to the server is based on a much broader set of criteria than what is in the claimed invention. The claimed invention in Claim 33 is limited to systems that preform methods where the client direction is based on one or more cost measurements indicative of the operational characteristics of the **network**. This is not related to any of the attributes listed by Colby in the cited section. Colby refers to attributes such as the **type of content**, the **QoS requirements** implied by the request, or **server load**; all of which are reported or interpreted as opposed to actual measurements. For this reason Colby does not teach one of the elements of Claim 33 and cannot therefor anticipate Claim 33. Applicants respectfully request reconsideration and passage to allowance of Claim 33.

Claims 11, 21, 30, 43, 53, 62, and 64 were rejected on grounds that they "have similar limitations as Claims 2, 4-8 and 11; therefore they are rejected under the same rationale." Applicants respectfully object to the form of this rejection. It is not sufficient that a claim element be "similar" to an element in another rejected claim under 35 USC § 102 in order for the rejection to be proper. Anticipation requires identity, *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 613, 225 USPQ 64 (CAFC 1985) the identical invention must be shown in as complete detail as is contained in the patent claim, *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989). Applicants further respectfully object to this rejection as informal because where the individual elements are said to be present in Claims 2, 4-8, and 11 is never explained. This is especially true because in the rejection of Claims 2, 4-8, and 11 the wording or functionality of the claim elements was not present nor inherency of function expressed in Claims 2, 4-8, and 11. Please refer to the above discussion which explains why the cited language in inapplicable. The language for the same rationale discussed above for Claims 2, 4-8, and 11 on the list of claims should be accepted. For each of these reasons Colby does not teach

the elements of Claims 11, 21, 30, 43, 53, 62, and 64 and cannot therefor anticipate Claims 11, 21, 30, 43, 53, 62, and 64. Applicants respectfully request reconsideration and passage to allowance of Claims 11, 21, 30, 43, 53, 62, and 64.

Claims 13, 14-18, 20, 23-27, 29, 34, 36-40, 42, 45, 46-50, 52, 55-59, and 61 were rejected on grounds that they "have similar limitations as Claim 32; therefore they are rejected under the same rationale." Applicants respectfully object to the form of this rejection it is not sufficient that a claim element be "similar" to an element in another rejected claim under 35 U.S.C. § 102 in order for the rejection to be proper. Anticipation requires identity, *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 613, 225 USPQ 64 (CAFC 1985) the identical invention must be shown in as complete detail as is contained in the patent claim, *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989). Applicants further respectfully object to this rejection as informal because where the individual elements are said to be present in Claim 32 is never explained. This is especially true because in the rejection of Claim 32 the wording or functionality of the claim elements was not present nor inherency of function expressed. In Claim 32 the above rejection stated that on column17, lines 38-58, column 18, line 63 to column19, line 7, and Fig. 19 teaches "A method for inferring operational characteristics associated with a plurality of network clients to an inferable network client, comprising:

> (a) measuring network latency between a network server and a plurality of network clients;
> (b) determining physical distances between said network clients and an inferable network client; and
> (c) computing a weighted average of said latency measurements as a function of said distances, wherein said weighed average comprises an estimate of the latency between said network server and said inferable network client."

Once again the cited language is not found in the reference at the points indicated. Note that the one-to-many relationship is reversed between Colby and the invention as described in the rationale for Claim 11. Colby makes no reference to inferring operational characteristics associated with a plurality of network clients to an inferable network client in any of the cited sections. Furthermore, for the same rationale as described for Claim 10, the weighting concept is applied for completely different purposes. The invention uses the technique in order to estimate latency while Colby on the other hand uses a method of weighting for bandwidth allocation of flows please refer to the above discussion which explains why the cited language in inapplicable. The language for the same rationale discussed above for Claims 2, 4-8, and 11

the list of Claims should be accepted. For each of these reasons Colby does not teach the elements of Claims 13, 14-18, 20, 23-27, 29, 34, 36-40, 42, 45, 46-50, 52, 55-59, and 61 were and cannot therefor anticipate Claims 13, 14-18, 20, 23-27, 29, 34, 36-40, 42, 45, 46-50, 52, 55-59, and 61. Applicants respectfully request reconsideration and passage to allowance of Claims 13, 14-18, 20, 23-27, 29, 34, 36-40, 42, 45, 46-50, 52, 55-59, and 61.

Claim 54 was rejected on ground that "it had similar limitations to Claim 22; therefore it is rejected under the same rationale." Applicants respectfully object to the form of this rejection. It is not sufficient that a claim element be "similar" to an element in another rejected claim under 35 U.S.C. § 102 in order for the rejection to be proper. Anticipation requires identity, *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 613, 225 USPQ 64 (CAFC 1985) the identical invention must be shown in as complete detail as is contained in the patent claim, *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989). The difference is that Claim 22 is a method claim and Claim 54 is directed toward a system that accomplishes the method. The only elements that Claims 22 and 54 have in common is element of "method for directing a network client requesting access to content from a network server to one of a plurality of content servers providing said content for said network server, each said content server having an address, said network server having an identity, said method comprising returning the address of a content server that may provide said content the identity of the network server based on one or more cost measurements indicative of operational characteristics of the network, obtaining a new cost measurement when said network client accesses said content server, and using said new cost measurement as an indicator of operational characteristics of the network in connection with subsequent requests for access to said content that can be provided by said content server." In the Office Action rejecting Claim 22, the Office Action states that Colby at column 2, lines 47-67; column 5, lines 62-67; column 10, lines 1-37; column 6, lines 42-64; column 3, lines 1-28; column 19, lines 8-19; and column 15, lines 10-47 teaches "method for directing a network client requesting access to content from a network server to one of a plurality of content servers providing said content for said network server, each said content server having an address, said network server having an identity, said method comprising returning the address of a content server that may provide said content the identity of the network server based on one or more cost measurements indicative of operational characteristics of the network, obtaining a new cost measurement when said network client accesses said content

server, and using said new cost measurement as an indicator of operational characteristics of the network in connection with subsequent requests for access to said content that can be provided by said content server." A check of the citation shows that this language is not present. The sections referred to in Colby do not in any way relate to obtaining a new cost measurement when said network client accesses said content server. Colby does refer to the selection of a server to deliver the content to a client, directing the client to the server is based on a much broader set of criteria than what is in the claimed invention. The claimed invention in Claim 22 is limited to methods where the client direction is based on one or more cost measurements indicative of the operational characteristics of the **network**. This is not related to any of the attributes listed by Colby in the cited section. Colby refers to attributes such as the **type of content**, the **QoS requirements** implied by the request, or **server load**; all of which are reported or interpreted as opposed to actual measurements. For this reason Colby does not teach one of the elements of Claim 54 and cannot therefor anticipate Claim 54. Applicants respectfully request reconsideration and passage to allowance of Claim 54.

Claim 44 was rejected on ground that "it had similar limitations to Claim 12; therefore it is rejected under the same rationale." Applicants respectfully object to the form of this rejection. It is not sufficient that a claim element be "similar" to an element in another rejected claim under 35 U.S.C. § 102 in order for the rejection to be proper. Anticipation requires identity, *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 613, 225 USPQ 64 (CAFC 1985) the identical invention must be shown in as complete detail as is contained in the patent claim, *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989). The difference is that Claim 12 is a method claim and Claim 44 is directed toward a system that accomplishes the method. The only elements that Claims 22 and 54 have in common is element of "identifying a said one of said content servers based on said identity of said network server and one or more cost measurements indicative of operational characteristics of the network." As to Claim 44, the Office Action rejecting Claim 12 states that Colby at column 2, lines 47-59; column 10, lines 1-39; and column 6, lines 42-63 teaches "identifying a said one of said content servers based on said identity of said network server and one or more cost measurements indicative of operational characteristics of the network." A check of the citation shows that this language is not present. The sections referred to in Colby do not in any way relate to obtaining a new cost measurement when said network client accesses said content server. Colby does refer to the selection of a

server to deliver the content to a client, directing the client to the server is based on a much broader set of criteria than what is in the claimed invention. The claimed invention in Claim 12 is limited to methods where the client direction is based on one or more cost measurements indicative of the operational characteristics of the **network**. This is not related to any of the attributes listed by Colby in the cited section. Colby refers to attributes such as the **type of content**, the **QoS requirements** implied by the request, or **server load**; all of which are reported or interpreted as opposed to actual measurements. For this reason Colby does not teach one of the elements of Claim 44 and cannot therefor anticipate Claim 44. Applicants respectfully request reconsideration and passage to allowance of Claim 44.

Claim Rejections - 35 U.S.C § 103

The basis for the rejections under this section relate to establishing that while the invention is not identically disclosed or described in a cited reference, the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. The invention of Claims 9, 19, 28, 31, 32, 41, 51, 60 and 63 are said to be obvious in view of the teachings of Colby in light of US Patent Number 6,526,283 to Jang entitled "Device and Method for Tracking Location of Mobile Telephone in Mobile Telecommunication Network" (herein referred to as "Jang"). Applicants respectfully traverse this rejection on the basis that Colby selects servers based upon content while the claimed invention selects based upon network characteristics. The claimed invention monitors the entire network to determine the best path, while Colby only receives network information from the selected server. The aforementioned discussions of the same under the 102 discussion are hereby incorporated by reference. Moreover, the Jang reference is non-analagous art in the cellular telephone field, and as such would not provide a basis for combination with the network related claimed invention. The rejections will be treated according to how they were grouped in the Office Action. In order to have a proper rejection under 35 U.S.C. §103, fundamental precepts of patent law must be followed. As MPEP 2143 provides, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest

all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488,20 USPQ2d 1438 (Fed. Cir. 1991). In the present case, no proper motivation to combine the references was provided in the Office Action. As for the improper combination of non-analagous voice and data arts, there is no expectation of success of a device based upon such a combination. Finally, it will become clear that the invention claim limitations are not found in the hypothesized combination of Colby with Jang.

According to the Office Action, it "would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Colby and Jang to have a performing a plurality of intersecting circle using distance equivalents a the radius of circle with network server locations as center and determining the physical location of client from the intersection of circle" which Applicants respectfully note does not make sense. The basis for combination was provided in the Office Action as "because it would have an efficient system that can provide specific degree or amount of separation between two points, lines, surfaces, or objects or an advance along a route measured linearly." The rationale provided, "because it would have an efficient system" is not a proper basis for rejection under 35 U.S.C. §103(a). This improper rationale is then followed by purely speculative determinations of qualities which an invention combining aspects of Colby and aspects of Jang might have 'that can provide specific degree or amount of separation...along a route measured linearly.' Efficiency is not cited as a problem in Colby which would lead one skilled in the art to seek out Jang for the purpose of combination. Moreover, Jang is distinguishable for a number of reasons, not the least of which is due to the fact that Jang addresses voice traffic instead of internet data, Jang deals with devices that are inherently designed to be mobile, while a particular Internet user is commonly at a fixed location, and finally the combination of the two teachings without a proper basis is likely to result in a non-functioning device, regardless if this chimerical combination is inferred to be a voice communication teaching or data hybrid.

For the rationale discussed in the previous section regarding the teachings of Colby, it is clear that the invention and the teachings of Colby are in fact very different. As such, the rejection of Claims 9, 19, 28, 31-32, 41, 51, 60, and 63 are not valid as presented. As for the general rejections of Claims 9, 19, 28, 31, 41, 51, 60 and 63 characterized as "Circular Intersection," the following response is provided. Claim 60 is representative of the limitations

also contained in Claims 9, 19, 28, 31, 41, 51 and 63, where it recites the circular intersection comprising:

> (a) measuring the time that it takes for data to move from a plurality of network server locations to said client;
> (b) converting said times to distance equivalents;
> (c) forming a plurality of intersecting circles using said distance equivalents as the radius of circles with said network server locations as the center; and
> (d) determining the physical location of said network client from the intersection of said circles.

The circular intersection method described above is distinctly different than the cited Jang reference. The abstract of the Jang patent describes the method for tracking the location of a mobile phone as follows (emphasis added):

> A device and method for tracking the location of a mobile telephone in multipath fading and a non-line-of-sight environment. In the device for tracking the location of a mobile telephone, each of a plurality of base stations receives a predetermined signal from the mobile telephone and calculates the distance between the mobile telephone and the base station based on the time of arrival of the signal at the base station. A location data processor receives information about the distances from the base stations, draws circles with the radii being the distances and the coordinates of the base stations at the centers thereof around the base stations, and determines the location of the mobile telephone using location tracking curves connecting the intersection points of the circles.

In short, the Jang patent describes how to find a mobile device for transmitting voice data as it moves among various cellular telephone cells based upon a predetermined signal from a mobile cellular device to a plurality of receivers. The claimed circular intersection steps recite the transmission from a plurality of servers to a remote client device. Apart from the different technologies, voice instead of IP protocols, and a multitude of other distinctions, the claimed invention recites a query step in the opposite direction! Consequently, not only has the first element for *prima facie* obviousness not been met due to lack of basis for combination, it is clear from the fundamentally different references that there is no reasonable basis for success based upon the hypothetical combination. According to MPEP 2143.02, "The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success." In re *Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Querying according to Jang does not occur according to the steps in Claims 9, 19, 28, 31, 41, 51 and 63 from a plurality of servers to a client, and as such would not function according to the claimed invention. The second requirement of *prima facie* obviousness of a reasonable basis of success

has not been met either. Computer clients and servers are distinctly different from cellular telephones and wireless base stations, and simply exchanging one element for another would clearly be non-functional for its intended purpose.

Finally, regardless of how Jang is characterized with Colby, it does not teach all the claim limitations of Claims 9, 19, 28, 31, 41, 51 and 63 and as such the rejection of these claims under 103 should be withdrawn. Neither Jang nor Colby teaches the claimed step of "measuring the time that it takes for data to move from a plurality of network server locations to said client" and as such the claimed invention is not taught by Colby in combination with Jang. There is no reason why one would substitute the servers and clients of Colby for the wireless base stations and cellular telephones of Jang, and moreover the claimed data pathways from a plurality of servers to said client is quite simply not found. Since none of the elements of *prima facie* obviousness have been met with respect to Claims 9, 19, 28, 31, 41, 51 and 63, Applicants respectfully request that the rejection of these claims under 103 be withdrawn.

With respect to the rejection of Claim 32, a method for inferring operational characteristics associated with a plurality of network clients to an inferable network client, the following elements are recited:

> (a) measuring network latency between a network server and a plurality of network clients;
> (b) determining physical distances between said network clients and an inferable network client; and
> (c) computing a weighted average of said latency measurements as a function of said distances, wherein said weighed average comprises an estimate of the latency between said network server and said inferable network client.

Colby makes no reference to inferring operational characteristics, and previous characterizations made with respect to Claim 32 under 102 are hereby incorporated by reference. In addition, the previous discussion with respect to the burdens of *prima facie* obviousness under 103 are also incorporated by reference, and rejection of Claim 32 is respectfully traversed. As for the particular aspects of Claim 32 with respect to the cited references, it is also important to note that Jang also lacks inferential characteristics. As stated in Jang's Summary of the Invention:

> The object of the present invention can be achieved by providing a device and method for tracking the location of a mobile telephone. According to the device for tracking the location of a mobile telephone, each of a plurality of base stations receives a predetermined signal from the mobile telephone and calculates the

> distance between the mobile telephone and the base station based on the time of arrival of the signal at the base station. A location data processor receives information about the distances from the base stations, draws circles with the radii being the distances and the coordinates of the base stations at the centers thereof around the base stations, and determines the location of the mobile telephone using location tracking curves connecting the intersection points of the circles.

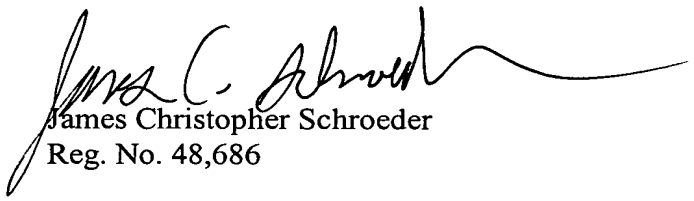
Consequently, Jang does not contain a teaching to infer operational characteristics, nor does it contain a basis to combine with Colby to undertake the same as described in Claim 32. Finally, please note that no specific basis of rejection under 103 was provided for Claim 32 and as such the rejection of Claim 32 is improper and should be withdrawn.

Since none of the elements of *prima facie* obviousness have been met with respect to Claims 9, 19, 28, 31, 32, 41, 51 and 63, Applicants respectfully request that the rejection of these claims under 103 be withdrawn.

CONCLUSION

The Applicants respectfully assert that the presently claimed invention is patentably distinct from the cited references. Accordingly, the Applicants respectfully assert that claims 1-64 are patentably distinct from the cited reference, and that Claims 1-64 overcome the cited art. Therefore, the Applicants respectfully request that the present rejections be withdrawn and that the instant application be passed to allowance. The Examiner is cordially invited to telephone the undersigned for any reason which would advance the instant application to allowance.

Respectfully submitted,



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